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10/524,354	02/14/2005	Koichi Goto	450100-05121	6316

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EXAMINER	
KARIMI, PEGEMAN	
ART UNIT	PAPER NUMBER
2629	
MAIL DATE	DELIVERY MODE
05/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/524,354	GOTO ET AL.	
	Examiner	Art Unit	
	PEGEMAN KARIMI	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03/09/2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6 and 8-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4-6 and 8-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on 03/09/2009 has been entered and considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 4-6, and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beernink (U.S. Patent No. 5,434,929) in view of by Dolan (U.S. Patent No. 5,148,015) and further in view of Dutta (U.S. Pub. No. 2002/0073204).

As to claims 1 and 11, Beernink teaches an input method using an input apparatus (10) in which

a touch panel (52 and 24') is laminated onto a display screen (72) of a display apparatus (50), (col. 5, lines 61-64),

a sensor unit (72) is formed so as to be expanded to the outside of one side of said display screen (i.e. 72 includes display screen 52 and keypad 24'. Keypad 24' is arranged outside of the side screen 52), (col. 4, lines 36-39)

an instruction (pop-up window of command icon) according to a touching position of a finger or a touch pen (38) onto said sensor unit is given (col.7, lines 39-47), and

a controller (18) generates a control signal on the basis of said instruction (col. 4, lines 1-2),

comprising the steps of:

displaying a selection display (76) comprising a plurality of selection items (82) along said side of said display screen (Horizontal side of the display) when the finger or the touch pen (38) is touched to said sensor unit (col. 8, lines 49-51, and lines 58-60);

and [[instructing selection of]] selecting said [[instructed]] highlighted selection item [[when]] upon lifting the finger or the touch pen (highlighting the elements of selection items 82 by touch pen 38 and selecting a desired selection by placing the touch pen on the screen and then lifting the touch pen), (col. 7, lines 45-50) from contact with said sensor unit (placing and then lifting the touch pen from the touch screen 51) at the position of the highlighted selection item and (col. 9, lines 43-49), [[wherein said selection display disappears when the finger or the touch pen is moved (lifted) from said sensor unit to said display screen side]] (tapping on box 94, which is located on the display screen side, col. 9, lines 15-19), (col. 7, lines 47-50).

Beernink does not mention highlighting selection item as the finger or touch pen moved along said side on said sensor unit. Dolan teaches instructing one of (as can be seen in Fig. 1, when the user places his/her finger on sensor 15' the selection option 25 is highlighted) highlighting said highlighted selection items when the finger or the touch

pen is near said selection items (col. 4, lines 56-63) as the finger or touch pen remains in contact with said sensor unit (as the user places his/her finger over the sensor the photo detector has activated and causes the selection to be highlighted) and is moved along said side on said sensor unit (col. 4, lines 64-67). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the highlighting selection item by the finger or the touch pen of Dolan to the input apparatus of Beernink because The highlighting of the desired selection by the user placing his finger over a reflective sensor lined up with the displayed item will normally be sufficient to inform the user of the choice that the has elected (col. 5, lines 6-9).

Beernink and Dolan do not teach cancelling a selection display when the finger or the touch pen remains in contact while moved from said sensor unit to said display screen on said touch panel. Dutta teaches cancelling a selection display (pop-up box containing data items) when the finger or the touch pen (cursor, which acts as a touch pen) remains in contact (moving the cursor over other host identifiers) while moved from said sensor unit (host identifier) to said display screen on said touch panel (in order to move from one host identifier to another the user must move over the display screen on the touch panel as can be seen in Fig. 6. when the user moves the cursor from one host identifier to another the pop-up box will open and close with the appropriate information). It should be noted that the prior art of Dutta does not mention a finger or a touch pen moving from the sensor unit to the display screen, however, Beernink teaches a touch pen 38, which can be used to move the cursor on the screen instead of the mouse or keyboard of Dutta. Therefore since the cursor is moved from one host

identifier to another and opens and closes the pop-up box data information, it can be concluded that when the touch pen is controlling the cursor in order for the cursor to move from one host identifier to another the stylus must remain in contact with the sensor unit.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the cancelling a selection display when the finger or the touch pen remains in contact while being moved from said sensor to the display screen on said touch panel of Dutta to the touch panel of Beernink as modified by Dolan because it would help the user to search faster and find information regarding a selection display faster through the menu options by eliminating the taping or double clicking.

As to claims 5 and 12, this claim differs from claim 1 only in that the limitations "a controller to which an instruction according to a touching position of a finger or touch pen onto said sensor unit is given".

Beernink teaches a controller (18) to which an instruction (pop-up window of command icon) according to a touching position of a finger or touch pen (38) onto said sensor unit is given (col. 7, lines 39-47), (the display assembly 20 of pen-based computer system 10 is both an input and an output device and is coupled to I/O circuitry 18 by a bi-directional data bus 37, also when the buttons are selected by engaging the touch pen 38 the pressure is sensed and communicated to CPU 12 via data bus 37 and I/O 18, Fig. 1).

As to claims 2 and 6, Beernink teaches, operating a predetermined button (64) on a display/sensor unit of said touch panel (24') overlapped with said display screen (24' overlaps 72), an instruction corresponding to said button is generated (col. 5, lines 23-27 and col. 7, lines 39-42).

As to claims 4 and 8, Beernink teaches the selection display is a menu display (col. 7, lines 45-47).

As to claim 9 and 10, Beernink teaches a selection operation is cancelled (quitting a session setting preference) and said selection display is continued when the finger or the touch pen is moved along said sensor unit to an end area of said sensor unit out of range of said selection items on said display screen (when the pen is moved to the close box 94, which is out of range of the selection items of the display screen and is at the end of the sensor unit, the user can select the close box 94 by tapping on the close box to quit a session setting preference and continue working on the display) and thereafter lifting up the finger or touch pen from said sensor unit to said display screen side (the tapping of the close box 94 requires the user to press the pen on the close box and then lift the pen in order to select the close box 94), (col. 9, lines 15-19).

As to claim 13, Beernink teaches the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66) is larger than the display screen (the display area is the area 20).

As to claim 14, Beernink teaches the touch panel (areas 20 and 24' combined) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 15, Beernink teaches the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66) is larger than the display screen (the display area is the area 20).

As to claim 16, Beernink teaches the touch panel (areas 20 and 24' combined) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 17, Beernink teaches the step of providing the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66, the touch panel 20 can be used as an input device by using a stylus 38, therefore the area

20 can be part of the touch panel) to be larger than the display screen (the display area is the area 20).

As to claim 18, Beernink teaches the step of providing the touch panel (areas 20 and 24' combined are the touch panel area because the area 20 can be used as an input device using the stylus 38) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 19, Beernink teaches the step of providing the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66, the touch panel 20 can be used as an input device by using a stylus 38, therefore the area 20 can be part of the touch panel) to be larger than the display screen (the display area is the area 20).

As to claim 20, Beernink teaches the step of providing the touch panel (areas 20 and 24' combined are the touch panel area because the area 20 can be used as an input device using the stylus 38) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

Response to Arguments

4. Applicant's arguments filed 03/09/2009 have been fully considered but they are not persuasive.

Applicant argues that the prior art does not show, teach or suggest "cancelling a selection display when the finger or touch pen remains in contact while being moved from the sensor unit to the display screen". Dutta teaches when the pointer 602 moves over host identifier and retrieves the thumbnail information, wherein as the user moves the cursor over other host identifiers the pop-up box will open and close with the appropriate information. The closing of the pop-up boxes is considered cancelling a selection display. Dutta does not mention a finger or touch pen remains in contact while being moved, but it would have been obvious to one of ordinary skilled would understand that the cursor can be controlled by a stylus or touch pen wherein by moving the stylus or touch pen the cursor can be moved. The user can move the cursor over the display screen by using a stylus or touch pen while remaining in contact with the display or the user can substitute the cursor on the screen with the finger, stylus, or the touch pen ([0070], lines 4-12).

Applicant argues that Dutta merely discloses moving a mouse in order to move a cursor/pointer 602 on the screen. The combination of prior art references of Dutta with

Beernink as modified by Dolan can be read on the claim wherein Dutta teaches as the user moves the cursor over other host identifiers the pop-up box will open and close with the appropriate information and the cursor can be replaced by the stylus or touch pen wherein the stylus or touch pen has to be in contact with the display screen and moving over the host identifiers in order for the pop-up boxes to open and close.

Applicant argues that Dutta merely discloses moving a cursor over other hosts to open and closure pop-up boxes. Dutta teaches user moving the cursor over other host identifiers and the pop-up box will open and close with the appropriate information.

Applicant argues that Nothing in Dutta teaches or suggests movement from a sensor unit to a display screen. The area wherein the host identifier 604 is located in is considered a sensor unit, and the area outside of the host identifier 604 is considered a display screen area. So, when the user is moving from host identifier 604 to another host identifier the cursor will move over the display screen area between the two host identifiers.

Applicant argues that since Dutta merely discloses moving a pointer over a host identifier to retrieve thumbnail information, nothing in Dutta shows teaches or suggests selecting an item by lifting a finger or touch pen from contact with a sensor unit. Dutta does not mention selecting an item by lifting a finger or touch pen from contact. Beernink teaches selecting and icon by tapping on the icon wherein the tapping refers to placing the stylus 38 on the screen and then lifting the stylus. Therefore a selection icon can be selected (col. 7, lines 45-49).

Applicant further argues that there is no contact involved in Dutta wherein the cursor is not in contact with the display screen but are merely pixels of the display screen highlighted in such a way that the cursor appears to move about the screen corresponding to movement of a mouse.

As was previously mentioned above the cursor of Dutta can be controlled by a stylus, finger, or touch pen wherein by moving the stylus instead of the mouse the user can move the cursor around the screen. The cursor of Dutta can also be replaced by the stylus of Beernink wherein the movement of the stylus can represent the movement of the cursor.

Examiner is not replacing the tapping motion of Beernink and the pressing of the bar of Dolan with the cursor/pointer of Duttan as mentioned by the applicant on last paragraph of page 10. The tapping motion of Beernink is not replaced and is still used for selection of icons. The cursor movement of Dutta to open and close pop-up boxes of host identifiers has been added to the input apparatus of Beernink as modified by Dolan because it would help the user to search faster and find information regarding a selection display faster through the menu option by eliminating the tapping or double clicking.

Examiner would like to point out that the examination of the applicants application is based on the combination of the reference of Beernink, Dolan, and Dutta.

Examiner would like to also add a prior art reference of Lindholm (U.S. Patent No. 5,748,192), which was not mentioned previously. Lindholm teaches a menu item is selected by moving the cursor to the vicinity of the menu item and any puldown meny

may be exited by simply moving the cursor outside the menu boundary (col. 16, lines 18-22).

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiry

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 9:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/
Examiner, Art Unit 2629
May 18, 2009

/Chanh Nguyen/
Supervisory Patent Examiner, Art Unit 2629